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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/786,917	02/25/2004	Teruhiko Tobinai	2630.3068.003(488SC)	2080

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EXAMINER

CHIESA, RICHARD L

ART UNIT	PAPER NUMBER
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1724

DATE MAILED: 09/13/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/786,917

Applicant(s)

TOBINAI ET AL.

Examiner

Richard L. Chiesa

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 February 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 25 February 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☒ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Priority

1. Acknowledgment is made of applicants' claim for foreign priority under 35 U.S.C. 119(a)-(d). The certified copy has been filed in parent Application No. 09/493,363, filed on January 28, 2000.

Response to Amendment

2. The preliminary amendment filed on February 25, 2004 has been entered.

Drawings

3. The drawings filed on February 25, 2004 are accepted by the examiner.

Reissue Applications

4. The reissue oath/declaration filed with this application is defective (see 37 CFR 1.175 and MPEP § 1414) because applicants have not identified the foreign application on which foreign priority is being claimed. The foreign application must be identified by specifying the application number, country, day, month, and year of its filing as required by 37 CFR 1.63(c). Contrary to applicants' statements on page 1 of the reissue declaration, there apparently was no form PTO/SB/02B (or equivalent) attached to the reissue declaration.

5. Claims 1-28 are rejected as being based upon a defective reissue declaration under 35 U.S.C. 251 as set forth above. See 37 CFR 1.175.

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The nature of the defect in the declaration is set forth in the discussion above in this Office action.

6. In accordance with 37 CFR 1.175(b)(1), a supplemental reissue oath/declaration under 37 CFR 1.175(b)(1) must be received before this reissue application can be allowed.

Receipt of an appropriate supplemental oath/declaration under 37 CFR 1.175(b)(1) will overcome this rejection under 35 U.S.C. 251. An example of acceptable language to be used in the supplemental oath/declaration is as follows:

“Every error in the patent which was corrected in the present reissue application, and is not covered by a prior oath/declaration submitted in this application, arose without any deceptive intention on the part of the applicant.”

7. Claims 14-22, and 25-27 are rejected under 35 U.S.C. 251 as being an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based. See *Pannu v. Storz Instruments Inc.*, 258 F.3d 1366, 59 USPQ2d 1597 (Fed. Cir. 2001); *Hester Industries, Inc. v. Stein, Inc.*, 142 F.3d 1472, 46 USPQ2d 1641 (Fed. Cir. 1998); *In re Clement*, 131 F.3d 1464, 45 USPQ2d 1161 (Fed. Cir. 1997); *Ball Corp. v. United States*, 729 F.2d 1429, 1436, 221 USPQ 289, 295 (Fed. Cir. 1984). A broadening aspect is present in the reissue which was not present in the application for patent. The record of the application for the patent shows that the broadening aspect (in the reissue) relates to subject matter that applicants previously surrendered during the prosecution of the application. Accordingly, the narrow scope of the claims in the patent was not an error within the meaning of 35 U.S.C. 251, and the broader scope surrendered in the application for the patent cannot be recaptured by the filing of the present reissue application.

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The recitation “axially extending projections” defined in the patented claims but omitted in the reissue claims 14-22, and 25-27 was a key limitation added to overcome an art rejection in the patented application. Furthermore, applicants argued on page 9, lines 4-9 of the amendment filed on August 16, 2001 in the patented application (SN 09/493,363) that neither U.S. Patent No. 4,073,278 to “Glenn nor any other cited references” discloses applicants’ coupling “projections”. It would appear that couplings without axial projections constitutes the surrendered subject matter. The substitute limitations now present in the above-noted reissue claims do not recite any coupling “projections” and appear to be merely restating in different phraseology but of same scope the relative rotation between the throttle valve and air valve which was originally present in the patented application at filing or in the preliminary amendment dated April 3, 2000.

Claim Rejections - 35 USC § 102/103

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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10. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicants are advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

11. Claims 14-17, and 25 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over U.S. Patent No. 3,439,658 to Simonet. Simonet (note Figures 1-5) discloses a carburetor body 3 having a scavenging air passage 4, fuel and air mixing passage 5, an air valve 6 in the scavenging passage 4, a throttle valve 7 in the fuel and air mixing passage 5, biasing spring 24, and a coupling 10, 17, 19 interconnecting the air valve and throttle valve as claimed (35 USC 102b). It would appear Simonet may not explicitly state that the throttle valve and air valve open at different times. However, Simonet does mention in col. 5, lines 62-67 that the coupling between the air valve 6 and throttle valve 7 may be modified or replaced by a different mechanism such that the two valves do not open or move by equal angles. Consequently, it is inherent or at least would have been readily obvious to one of ordinary skill in the art (35 USC 103a) in view of Simonet's discussion that Simonet's valves open at different times.

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12. Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Simonet in view of U.S. Patent No. 4,333,429 to Iiyama et al. Simonet, as described above in paragraph 11, discloses a carburetor substantially as claimed. Apparently, Simonet does not explicitly disclose inclined edges on the air valve. However, Iiyama et al teach the well-known use of inclined edges on a carburetor valve (note Figures 4, 5, and Abstract) for the purpose of ensuring effective air flow control. Therefore, it would have been obvious to one having ordinary skill in the art to employ inclined edges on the Simonet carburetor air valve in order to facilitate optimum air flow control as taught by Iiyama et al.

13. Claims 19, 20, 26, and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Simonet in view of U.S. Patent No. 4,073,278 to Glenn. Simonet, as described above in paragraph 11, discloses a carburetor substantially as claimed. However, Simonet may not explicitly disclose the use of shafts for carrying the air and throttle valves. In any case, Glenn (note ref. num. 32, 35, 36, Figures 2-6) teaches the well-known use of shafts carrying air and throttle valves in a carburetor for the purpose of ensuring proper rotation of the valves (note col. 7, lines 22-40). It would have been obvious to one of ordinary skill in the art to employ shafts for carrying the air and throttle valves in the Simonet carburetor in order to facilitate rotation as taught by Glenn.

14. Claims 21 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Simonet, taken together with Glenn, as applied to claim 19 in paragraph 13 above, and further in

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view of U.S. Patent No. 5,036,816 to Mann. Simonet, taken together with Glenn, discloses a carburetor substantially as claimed with the apparent exception of parallel and coaxial carburetor valve shafts. Mann (note ref. num. 4-7, Figures 1-7) teaches the well-known use of both parallel and coaxial valve shafts in a carburetor for the purpose of maximizing valve coupling and movement (note col. 3, line 54 to col. 4, line 68). It would have been obvious to one having ordinary skill in the art to employ both parallel and coaxial valve shafts in the Simonet and Glenn carburetor in order to facilitate valve motion as taught by Mann.

Allowable Subject Matter

15. Upon the filing of a proper supplemental reissue declaration or oath, claims 1-13 would be allowable.

16. Upon the filing of a proper supplemental reissue declaration or oath, claims 23, 24, and 28 would be allowable if rewritten to include all of the limitations of the base claim and any intervening claims.

17. As allowable subject matter has been indicated, applicants' reply must either comply with all formal requirements or specifically traverse each requirement not complied with. See 37 CFR 1.111(b) and MPEP § 707.07(a).

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Conclusion

18. The prior art made of record and not relied upon is considered pertinent to applicants' disclosure. These references have been cited as art of interest to show other carburetors.

19. Applicants are notified that any subsequent amendment to the specification and/or claims must comply with 37 CFR 1.173(b).

20. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Richard L. Chiesa whose telephone number is (571) 272-1154.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Duane S. Smith, can be reached at (571) 272-1166.

Any inquiry of a general nature or relating to the status of this application should be directed to the Technology Center 1700 receptionist whose telephone number is (571) 272-0987.

Facsimile correspondence must be transmitted through (703) 872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Richard L. Chiesa
April 12, 2005

Richard L. Chiesa

**RICHARD L. CHIESA
PRIMARY EXAMINER
ART UNIT 1724**

April 12, 2005